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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ENG, DAVID Y

ART UNIT PAPER NUMBER

2155

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/644,337

Applicant(s)

BROERMAN, KEITH ROBERT

Examiner

DAVID Y. ENG

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/23/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Details of the rejection have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

In response to Applicants' communication filed on June 18, 2003, the Examiner carefully studied the excerpts identified by Applicants. Although some claim languages are in the excerpts, the Examiner is unable to find any explanation as to how the method steps as recited in the claim combination are able to facilitate communication between different networks in a bi-directional communication system.

Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Details of the rejection have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

Further with respect to claim 3, there are two claims numbered as 3.

In response to the section 112 Rejection, Applicants point to Figure 7 for the support of hierarchical protocol layers. There is no description of Figure 7 in the specification. There is no description of how the layers of Figure 7 are related to the two networks (Internet and the Ethernet) shown in Applicants' Figures 1 and 2. The

specification merely identifies in which rectangular box of Figure 7 the steps of Figure 3 are executed. The claim limitations therefore are not understood.

Applicants' remark with respect to claim 6 is not understood. Step 2 uses and not supplies the MAC address.

Applicants' remarks directed to claims 6-17 are not understood. The claims clearly call for a method for processing IP data and not using IP data as argued by Applicants. Furthermore, substituting an address of a payload is not processing the payload.

For the reasons set forth in the rejections above, Applicants are requested to map each of the claimed elements in the specification so that the Examiner better understands Applicants' intended limitations.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slemmer (USP 6,377,990).

With respect to claims 1, 4, 6, 7, 18, 19, 21 and 22, Slemmer teaches, in a bi-directional communication system (see at least Figure 1 in Slemmer), a method for communicating packetized (line 56 of column 3) data between different networks (Internet and network 20 in Figure 1) using hierarchical layers of communication protocols (lines 44-46 of column 3), comprising the steps of:

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comparing (line 24-35 and 43-50 of column 4) a received IP packet destination address in a first protocol layer with a predetermined IP address to determine if there is an address match; and

redirecting a payload (in bound message) of said received IP packet from an Internet network to a local network in response to said address match by substituting (line 25-28 of column 3 and line 33-43 of column 5) a second protocol layer address for a received second protocol layer address.

Although Slemmer did not explicitly state that the payload is for supporting applications, one of ordinary skill in the art should readily recognize that the workstations of Slemmer are capable of executing applications and the payload could have been used for supporting applications.

With respect to claim 2, it is inherent that the payload would be directed to a different destination if the addresses do not match (the packet arrives at the wrong address or wrong network). It is further inherent that the two different IP packets would operate at different networks to support different applications concurrently if they do not belong to the same network.

With respect to claims 3, 4, 6, 7, MAC address is well known in cable modem.

With respect to claims 5, 13, 20, the workstations of Slemmer are capable of executing any applications labeled as home appliance control, peripheral control etc.

With respect to claim 8, the IP addresses of Slemmer's LAN are for private and non-public usage.

For Claims 9, 14 and 22, see the term "replaces" in line 26 of column 3 and line 38 of column 5 in Slemmer.

With respect to claims 10, 11, 12 13, see Figure 1 of Slemmer shows communication between Internet and network LAN 20.

With respect to claims 15 and 22, see "modem" in line 22 and 33 of column 1.

With respect to claim 16, mapping database (associating table) is inherent in a system which replaces one address with another.

With respect to claim 17, the LAN layer is a different than the Internet layer in Figure 1 of Slemmer.

In the communication filed on June 18 2004, Applicants stated that they do not understand the nature of the rejection, as the Examiner does not establish a prima facie under section 103 as to indicate how the Slemmer reference with the Examiner's non-art renders all the claimed elements obvious. Applicants' statement has no support. In the Office action mailed on December 18, 2003, the Examiner clearly mapped each of the claimed elements by identifying the lines and columns in Slemmer. Patent examining is not looking for Applicant's claims in the references. Applicants fail to provide any explanation as to what elements are not taught by Slemmer. Merely blanketly stating the Examiner did not meet the prima facie case of obviousness is not enough to overcome the rejections. In reply to a rejection of claims in an application, Applicants must clearly point out the patentable novelty which he or she thinks present in view of the state of the art disclosed by the reference cited. See 37CFR1.111c. Simply pointing out what a claim requires with no attempt to point out how the claim


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patentably distinguishes over the prior art does not amount to a separate argument for patentability. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 525, 1528 (Fed. Cir. 1987).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to DAVID Y. ENG at telephone number 703-305-9691.



DAVID Y. ENG  
PRIMARY EXAMINER